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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,743	05/04/2005	Stephen C P Joseph	58117US004	4553
32692	7590	10/28/2008		
3M INNOVATIVE PROPERTIES COMPANY				
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ST. PAUL, MN 55133-3427				
EXAMINER				
GONZALEZ, MADELINE				
ART UNIT		PAPER NUMBER		
1797				
NOTIFICATION DATE		DELIVERY MODE		
10/28/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/533,743

**Applicant(s)**

JOSEPH, STEPHEN C P

**Examiner**

MADELINE GONZALEZ

**Art Unit**

1797

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6, 7 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 7 and 9-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

In response to applicant's amendment dated July 15, 2008

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 9, 10, 14, 17 and 18 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltenbach (U.S. 3,432,104) in view of Williams (U.S. 5,061,303).

With respect to **claim 10**, Kaltenbach discloses a spray gun siphon cup, as shown in Fig. 1, having:

- a container 30, as shown in Fig. 2, having a collapsible side wall 20 and a base on which it can stand unsupported in an upright position and having a filler opening and a filter 32;
- the filter 32 including an elongate tubular body closed at one end and open at the other end, the open end being provided with a support collar that is integral with the tubular body of the filter 32 and fits in the filler opening so that the filter body extends away from the opening within the container 30; and

- wherein the tubular body of the filter 32 has a surface area and volume within the container 30; and
- the filter 32 is sufficiently rigid to maintain an elongate, tubular shape.

Kaltenbach **lacks** the filter 32 being sufficiently flexible to allow it to collapse as the container side wall collapses.

Williams discloses a filter bag unit 24, as shown in Fig. 2, said unit 24 being collapsible in order to easily remove and install the unit, as shown in Fig. 4. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the filter disclosed by Kaltenbach with a collapsible filter as taught by Williams in order to easily remove and install a filter bag (see col. 6, lines 45-47).

With respect to **claim 6**, Williams discloses wherein the support collar 42 of the filter 24 is connected to a cage 40 that surrounds the tubular body of the filter 24 within the container 10 which cage 40 is sufficiently flexible to allow the filter 24 to collapse if the container containing it collapses, as shown in Fig. 4.

With respect to **claim 7**, Williams discloses wherein the cage 40 includes a plurality of legs 48 extending from the support collar 42 at the open end of the tubular body to a base member at the closed end of the tubular body, as shown in Fig. 2.

With respect to **claim 9**, Williams discloses wherein the tubular body of the filter 24 is provided with at least one annular support hoop 50, 54, spaced from the collar 42, as shown in Fig. 2.

With respect to **claim 14**, Kaltenbach discloses wherein the elongate tubular body of the filter 32 is tapered toward the closed end, as shown in Fig. 3.

With respect to **claim 17**, Kaltenbach discloses wherein the opening is not an open end of the container, since the opening is on the cover 28, as shown in Fig. 3. The term "filler opening" has been considered an intended use recitation.

With respect to **claim 18**, Kaltenbach discloses a container 19 and a circular lid 28, and the opening is separate from an opening (such as the open end of the container 30) to be connected to a spraying apparatus and is in the lid 28 and has a diameter of one-half the diameter of the lid or less, as shown in Fig. 3.

Claims 15 and 16 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltenbach (U.S. 3,432,104) in view of Williams (U.S. 5,061,303) as applied to claim 10 above, and further in view of Brown (U.S. 2,175,714).

**Claim 15** adds the further limitation of wherein the tubular body of the filter is oriented at an angle that is not parallel to the side wall of the container.

**Claim 16** adds the further limitation of wherein the container is characterized by a shape having a longitudinal axis and the filler opening is offset from the container longitudinal axis.

Kaltenbach as modified by Williams **lacks** the limitations of claims 15 and 16.

Brown discloses a filtering receptacle, as shown in Fig. 1, having a filter 13 oriented at an angle not parallel to a side wall of a receptacle 1, and an opening 4 offset from the receptacle 1 longitudinal axis. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to relocate the filter and opening disclosed by Kaltenbach to an angle not parallel to the side wall of the container, and offset from the longitudinal axis of the reservoir, respectively, as taught by Brown since the courts have held that shifting the position of a particular element is unpatentable as long as the operation of the device is not modified (see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)).

Claims 11-13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gerhenson et al. (U.S. 5,755,962) [hereinafter Gerhenson].

With respect to **claim 11**, Gerhenson discloses a filter assembly, as shown in Fig. 6, having:

- a container 20 having a filler opening, and a filter 3;
- the filter 3 including an elongate tubular body closed at one end and open at the other end, the open end being provided with a collar 24 that fits in the filler

- opening so that the filter body extends away from the opening within the container 20;
- wherein the container 20 includes an open-topped container and a lid 26 arranged to close the open end of the container 20 and forming the end wall in which the filler opening is formed, the container 20 being collapsible as liquid is withdrawn from the container and the filter 3 is sufficiently rigid to maintain an elongate, tubular shape and sufficiently flexible to allow the filter to collapse as the container collapses, as shown in Fig. 6.

Gerhenson **lacks** the support collar being integral with the tubular body of the filter.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the support collar disclosed by Gerhenson integral with the tubular body of the filter, as claimed by applicant, in order to facilitate its handling, since the courts have held that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering choice. (*See MPEP 2144.04 [R-1] (V) [In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)]*).

With respect to **claim 12**, Gerhenson discloses wherein the container has a flexible sidewall and a comparatively rigid base and the sidewall can be foldable to move the base towards the lid as liquid is withdrawn from the container, since the

container can be another filter 3 having a semi-rigid shape, as shown in Fig. 8 (see col. 3, lines 8-10).

With respect to **claim 13**, Gershenson discloses wherein the lid is provided with an extension sleeve 72 surrounding the container to provide support for the container, as shown in Fig. 8.

### ***Response to Arguments***

Applicant's arguments filed on July 15, 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that element 20 in Gershenson would not function as a container to be connected to a hand held spray gun: The filter bag 20 is containing layers 8, 10, 3, as shown in Fig. 6, and therefore, can be considered as a container. The limitation "being connectable in use to a spray gun for supply of the liquid to an inlet of the spray gun" is considered to be a recitation of the intended use of the claimed invention which must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the filter bag 20 can be connected to a spray gun, Unless applicant provides evidence showing the contrary. Furthermore, applicant is not positively claiming the spray gun.



With respect to the lid claimed in claim 11: Element 26 has been considered as a lid since it is covering the upper part of the filter bag 20, as shown in Fig. 6.

Applicant's arguments with respect to claims 11-13 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MADELINE GONZALEZ** whose telephone number is

(571)272-5502. The examiner can normally be reached on M, T, Th, F- 8:30am-5:00pm, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeline Gonzalez  
Patent Examiner  
October 21, 2008

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797